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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,078	12/04/2003	Jay R. Patel	I 1999.486 US D2	8832

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EXAMINER

SALIMI, ALI REZA

ART UNIT PAPER NUMBER

1648

DATE MAILED: 11/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/729,078

Applicant(s)

PATEL, JAY R.

Examiner

A R. Salimi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 10/070,285.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/4/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The receipt of preliminary amendment of 12/4/03 is acknowledged. Claims 1-5 have been canceled. Claims 6-8 are pending before the examiner.

Priority

An application in which the benefits of an earlier application are desired must contain a specific reference to the earlier filed application(s) in the first sentence of the specification (37 CFR 1.78). This statement should be **updated** as to reflect the latest status of the priority application.

Claim Rejections - 35 USC § 112

Claims 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 is vague and indefinite for recitation of “non-toxic mutagen”, the intended mutagen is not defined. Is SDS intended? In addition, claim is confusing for recitation of “about”, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Does 30 or 37 degree Celsius falls within the limitations of “about” ? This affects the dependent claims 7-8.

Claim 7 is vague and indefinite for recitation of “derivative thereof”, since the intended metes and bounds of the “derivatives” is/are not defined. The claim has been interpreted in light of the specification, but since the disclosure is deficient the claim is indefinite.

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Claim 8 is vague and indefinite, because claim is dependent on a canceled claim 1.

Correction is requested.

Claim Rejections - 35 USC § 112

Claim 7 is rejected under 35 U.S.C. § 112, first paragraph, as the disclosure is not enabling for the said claims. The specification does not provide a repeatable method for obtaining an EHV-1, and it does not appear to be readily available material. Deposit of virus strains of EHV-1 would satisfy the enablement requirements of 35 U.S.C. 112. Applicant's deposit statement on specification page 1 is noted, however, the statement does not indicate the extent of public availability.

If a deposit is made under the terms of the Budapest Treaty, then an affidavit or declaration by applicants or someone associated with the patent owner who is in a position to make such assurances, or a statement by an attorney of record over his or her signature, stating that the deposit has been made under the terms of the Budapest Treaty and that **all restrictions imposed by the depositor on the availability to the public of the deposited material will be irrevocably removed upon the granting of a patent**, would satisfy the deposit requirements. See 37 CFR 1.808.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Boxall et al (GB 1,570,732).

The claimed invention is anticipated by the claims and teaching of Boxall et al. The product taught and claimed by Boxall et al meets the broad limitations of the now claimed invention (see for example claims 8, 10, 13, 23). Moreover, if the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The limitation of 33 degree C meets the limitation of "about" 34 degree C (see for example claims 8, 10, 13, 23). Additionally, the teaching of Boxall et al reads on "derivative thereof" limitation of claim 7. Applicant is reminded that the Patent Office does not have facilities to perform physical comparisons between the claimed product and similar prior art products, and the disclosure does not provide a head to head study of the product claimed and the product taught by the above cited patent. Hence, the cited patent anticipates the claimed invention.

Claims 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Osterrieder et al (Virology, 1996, Vol. 226, pages 243-251).

The claimed invention is anticipated by the claims and teaching of Osterrieder et al. The now claimed product was previously known in the art as taught by Osterrieder et al meets the broad limitations of the now claimed invention, including, "derivative thereof" limitation of

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claim 7 (see page 244, 2nd full paragraph). Moreover, if the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The limitation of 33 degree C meets the limitation of "about" 37 or 40 degree C as defined on page 244. Applicant is reminded that the Patent Office does not have facilities to perform physical comparisons between the claimed product and similar prior art products, and the disclosure does not provide a head to head study of the product claimed and the product taught by the above cited prior art reference.

No claims are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. R. Salimi whose telephone number is (571) 272-0909. The examiner can normally be reached on Monday-Friday from 9:00 Am to 6:00 Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (571) 272-0902. The Official fax number is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be

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obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A. R. Salimi

11/5/2005


ALI R. SALIMI
PRIMARY EXAMINER